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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,177	12/27/2000	Yuki Yamamoto	1046.1229/JDH	2992

21171 7590 01/24/2006

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EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2178

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,177

Applicant(s)

YAMAMOTO ET AL.

Examiner

Adam M. Queler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 21-24, 31-34 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 21-24, 31-34 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed and RCE 11/23/2005.
2. Claims 1-12, 21-24, 31-34 and 39 are pending in the case. Claims 1, 8, 21, 23, 29, 30, 31, 33 and 39 are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/23/2005 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 39 recites the "tagged document ... displays the text." This is clearly not possible as the tagged document is what is being displayed; a document cannot display anything. For examining purpose only, it will be taken to mean that something displaying the tagged document simultaneously displays the text.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claim 39 is rejected under 35 U.S.C. 102(e) as being anticipated by Ito (US006330529B1).**

Regarding independent claim(s) 39, Ito discloses translating text in a first language into text in a second language c4.58-65. Ito discloses displaying a tagged document, and simultaneously displaying the text in the first and second language and includes a language tag (col. 6, ll. 18-28).

8. **Claims 1-12,21-24 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano et al. (US006047252A, filed 6/30/1997) and further in view of Ito.**

Regarding independent claim(s) 1, 21, and 31, Kumano teaches setting a language tag designating a type of language (col. 6, ll. 3-7). Kumano teaches that the tags are attached to constituent units of the original and translated portions (col. 4, ll. 38-45). Kumano does not teach combining these documents together. Ito teaches embedding an original text in a translated version (col. 5, ll. 35-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ito and Kumano, thereby embedding the original text in the translated version, as this would give Kumano the option of additionally displaying the original text as a pop-up (col. 6, ll. 18-28), while still retaining the option of Kumano's original display.

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This would be desirable because it would provide a user another way to view data that could be less obtrusive as it would display the original in response to a user's request (col. 6, ll. 27-28).

Regarding independent claim(s) 8, 23 and 33, Kumano teaches setting a language tag designating a type of language (col. 6, ll. 3-7). Kumano teaches that the tags are attached to constituent units of the first and second portions (col. 4, ll. 38-45). Kumano does not teach combining these documents together. Ito teaches embedding a first text in a second version (col. 5, ll. 35-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ito and Kumano, thereby embedding the first text in the second version, as this would give Kumano the option of additionally displaying the first text as a pop-up (col. 6, ll. 18-28), while still retaining the option of Kumano's original display. This would be desirable because it would provide a user another way to view data that could be less obtrusive as it would display the first text in response to a user's request (col. 6, ll. 27-28).

Regarding dependent claim(s) 2, the combination of Kumano and Ando was obvious as described above. Ando teaches the embedding results in a document indicative of a correspondence between the original and translated document (Fig. 5)

Regarding dependent claim(s) 3, Kumano teaches translating the original to create the translated version (col. 4, ll. 46-52).

Regarding dependent claim(s) 4, Kumano teaches the original is in a tagged document (Fig. 5).

Regarding dependent claim(s) 7 and 12, Kumano teaches that a browser interprets and displays the tags (col. 6, ll. 21-27).

Regarding dependent claim(s) 9, Kumano teaches the texts are related to each other (col. 4, ll. 38-45)

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Regarding dependent claim(s) 5, 10, 22, 24, 32 and 34, Kumano does not teach invisibility.

Ito teaches setting a tag controlling any document portion so that the original is invisible c6.1-10.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ito and Kumano, thereby embedding the first (original) text in the second (translated) version, as this would give Kumano the option of additionally displaying the first text as a pop-up (col. 6, ll. 18-28), while still retaining the option of Kumano's original display. This would be desirable because it would provide a user another way to view data that could be less obtrusive as it would display the first text in response to a user's request (col. 6, ll. 27-28).

Regarding dependent claim(s) 6 and 11, Kumano and Ito teach that one of the versions is invisible as explained in claim 5 above. Additionally, since the tags are HTML, all tags, including the invisibility tag, would inherently be in an invisible state.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140.

The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
1/20/2006